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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,141	07/16/2003	Donald H. Gehring	032531.000002	1223

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EXAMINER

MAYO, TARA L

ART UNIT

PAPER NUMBER

3671

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,141

Applicant(s)

GEHRING, DONALD H.

Examiner

Tara L. Mayo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 18-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-10 and 14 is/are rejected.
- 7) ☒ Claim(s) 3-5, 11-13 and 15-17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/09/05, 07/16/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 through 17, drawn to an offshore system with means for restricting lateral movement and heave, classified in class 405, subclass 223.1.
 - II. Claims 18 through 30, drawn to an offshore system with a pile anchor and means for dampening heave, classified in class 405, subclass 224.
 - III. Claims 31 and 32, drawn to an offshore system with a caisson and piston for dampening heave, classified in class 405, subclass 224.1.
 - IV. Claims 33 through 36, drawn to an offshore system with a piling and socket for dampening heave, classified in class 405, subclass 224.
 - V. Claims 37 through 45, drawn to a method of mooring a hull, classified in class 405, subclass 224.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I through IV are directed to related systems for restricting the movement of an offshore vessel. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed are exclusive of one another and not taught to be obvious

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variants. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed does not require the structural limitations of the process as claimed, therefore, being capable of use in a materially different process. For example, “heavy liquid” is required by the process.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. During a telephone conversation with James E. Bradley on 31 August 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 through 17.

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Affirmation of this election must be made by applicant in replying to this Office action. Claims 18 through 45 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

6. The drawings were received on 16 July 2003 and 15 December 2003. These drawings are acceptable.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Blakseth et al. (U.S. Patent Publication No. 2005/0123358 A1).

Blakseth et al. '358, as best seen in Figures 2 and 4, teach an offshore system comprising:
with regard to claim 1,

a buoyant hull (2);

a tendon assembly (1);

a counterweight (6) at a lower end of the tendon assembly;

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an anchor member (12); and

an engaging member (14) that telescopingly engages the upper end of the anchor member;

with regard to claim 2,

wherein the upper end of the anchor member and the engaging member are tubular; and

with regard to claim 14,

wherein the tendon assembly comprises

an upper riser section (26) extending downward from the hull and a lower tendon section (24) extending downward from the upper riser section, the upper riser section being larger in diameter and shorter in length than the lower tendon section, and further including an upper weight (36) secured to a lower end of the upper riser section.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6 through 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blakseth et al. (U.S. Patent Publication No. 2005/0123358 A1).

Blakseth et al. '358 further teach:

with regard to claim 6,

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an internal riser (4) located in the tendon assembly and extending to the hull;
with regard to claim 7,

a flowline (22) adapted to be coupled to well equipment on the sea floor and extending to the counterweight;

with regard to claim 8,

at least one external riser; and
with regard to claim 10,

a plurality of external risers.

Blakseth et al. '358 fail to teach:

with regard to claims 6 and 7,

a plurality of internal risers, each having a separate axis;

with regard to claim 7,

a plurality of flow lines;

with regard to claims 8 and 10,

a plurality of external risers engaging the counterweight; and
with regard to claim 9,

an anti-rotation device between the engaging member and the upper end of the anchor member for preventing rotation of the engaging member relative to the anchor member.

With regard to claims 6 and 7, it would have been obvious to one having ordinary skill in the art of offshore structures at the time of invention to modify the system disclosed by Blakseth

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et al. '358 such that it would include additional internal risers, each having a separate axis since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. The motivation would have been to provide the system with means for conveying greater quantities of fluid to the surface.

With regard to claim 7, it would have been obvious to one having ordinary skill in the art of offshore structures at the time of invention to modify the system disclosed by Blakseth et al. '358 such that it would include additional flowlines since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. The motivation would have been to provide the system with means for conveying greater quantities of fluid to the surface.

With regard to claims 8 and 10, it would have been obvious to one having ordinary skill in the art of offshore structures at the time of invention to modify the system disclosed by Blakseth et al. '358 such that it would include external risers. The motivation would have been to provide the system with additional means for conveying fluid to the surface.

With regard to claim 9, it would have been obvious to one having ordinary skill in the art of offshore structures at the time of invention to modify the system disclosed by Blakseth et al. '358 such that it would further include an anti-rotation device between the engaging member and the anchor member since the Examiner takes Official Notice of the use of anti-rotation devices for reducing the stress in connections to the seabed.

Allowable Subject Matter

11. Claims 3 through 5, 11 through 13 and 15 through 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara L. Mayo whose telephone number is 571-272-6992. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

tlm
31 August 2006



TARA L MAYO
PATENT EXAMINER